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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,077	03/16/2007	Mark Ellis	HPL-0001	9490
29344	7590	12/18/2008	EXAMINER	
MILLS & ONELLO LLP ELEVEN BEACON STREET SUITE 605 BOSTON, MA 02108			ANDERSON, AMBER R	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,077	Applicant(s) ELLIS, MARK	
	Examiner AMBER R. ANDERSON	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/18/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to Application filed on December 22, 2005 in which claims 1-12 are presented for examination.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a communication device, classified in class 2, subclass 410.
 - II. Claim 12, drawn to a method of coaching a student, classified in class 2, subclass 69.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the communication device of Claims 1-11 could be used in a different method than claimed in Claim 12.
3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

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- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after

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the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Mr. David Mellow on December 10, 2008 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claim 12 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the controls, microphone, receiver, etc. must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. Claim 4 recites the limitation "the radio receiver controls" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claims 5 and 6 are also rejected under 112 2nd paragraph as depending on Claim 4.

8. Claim 9 recites the limitation "the rechargeable power source" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the term "appropriate" means or what constitutes "an appropriate electromagnetic field" to make the device work. What is the structure that enables the controls to operate by electromagnetic field.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-4, 7, 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinoda et al. (EP 237,290 A1).**

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Regarding Claim 1, Shinoda et al. disclose a communication device for use in sporting activities, student coaching and other related activities, the device comprising a radio signal receiver and an associated power source arranged to receive radio signals from a transmission source and convert the radio signals into an audio signal reproduced on at least one audio speaker, the radio receiver being enclosed within a helmet to form a self-contained unit whereby the ingress of undesirable contaminants into the receiver is prevented, wherein the helmet is wearable by a user to allow the user to receive audio signals, whilst affording the user at least some protection from injury.

Regarding Claim 2, Shinoda et al. disclose wherein the radio receiver is enclosed in one of a plastics, resin and foam-like substance (Col. 3, lines 52-63 and Col. 4, lines 32-45).

Regarding Claim 3, Shinoda et al. disclose wherein the power source is a rechargeable batter which is enclosed within the self-contained unit (52, Fig. 11B; Col. 10, lines 5-7).

Regarding Claim 4, Shinoda et al. disclose wherein the radio receiver controls are contained within the self-contained unit (Fig. 11B).

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Regarding Claim 7, Shinoda et al. disclose wherein the radio signal receiver is located at a rear portion of the helmet (11, 18; Fig. 1 where a portion of the receiver is located in the rear of the helmet).

Regarding Claim 8, Shinoda et al. disclose wherein the radio signals are transmitted in the UHF frequency band (Col. 5, lines 25-30).

Regarding Claim 10, Shinoda et al. disclose further including a radio transmitter (10, 17) capable of transmitting a signal to the transmission source (Col. 5, lines 3-10).

Regarding Claim 11, Shinoda et al. disclose further including a microphone (14) capable of capturing audio signals which are provided to the radio transmitter for transmission to the transmission source (Col. 4, lines 57-58 indicating that the audio received from the microphone will be transmitted).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 5, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinoda et al. (EP 237,290 A1).

Regarding Claim 5, Shinoda et al. disclose radio receiver controls (50, 51) but is silent as to how they are operated. However, it is understood that having the structure of the claim would enable a device to be capable of functioning as claimed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to control the radio receiver controls by an electromagnetic field.

Regarding Claim 6, Shinoda et al. disclose radio receiver controls (50, 51) but is silent as to how they are operated. However, it is understood that having the structure of the claim would enable a device to be capable of functioning as claimed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to control the radio receiver controls by the use of infra-red signals, radio signals or the application of a magnetic field.

Regarding Claim 9, Shinoda et al. disclose a rechargeable power source (Col. 10, lines 5-7) but is silent as to how they are recharged. However, it is understood that having the structure of the claim would enable a device to be capable of functioning as claimed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recharge the power source by magnetic induction.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the designs of the helmets with audio systems of Kawaguchi et al. (USPN 4,648,131), Rainey (US PG Pub 2006/0025230), Jackson (USPN 5,438,702), Yard et al. (US PG Pub 2006/0293092), Lee (US PG Pub 2006/0121950), Drefko et al. (USPN 4,357,711), and White (USPN 4,152,553).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMBER R. ANDERSON whose telephone number is (571) 270-5281. The examiner can normally be reached on Mon-Thur, 8am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AMBER R ANDERSON/

December 15, 2008

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Examiner, Art Unit 3765

/Gary L. Welch/

Supervisory Patent Examiner, Art Unit 3765